

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

Kenichiro SAKAI et al.

Serial No. 09/819,703 Group Art Unit: 2628

Confirmation No. 4089

Filed: March 29, 2001

Examiner: Hau H. Nguyen

For: IMAGE DISPLAY DEVICE AND DATA WRITING METHOD IN IMAGE DISPLAY DEVICE

REPLY BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Siri

This is in response to the Examiner's Answer mailed February 21, 2008. On pages 3-5 of the Examiner's Answer, the Examiner repeated verbatim the rejection of claims 1-5 and 7-15 on pages 2-4 of the March 15, 2007 Office Action, except that "and magnification" was added at page 4, lines 4-5. The Response to Argument in item (10) on pages 5-6 of the Examiner's Answer is addressed below.

The Examiner's Answer first asserted that Nunokawa et al. disclosed "writing display information for indicating a display state" at column 8, lines 47-49. This portion of Nunokawa et al. (with the addition of line 50) states "information including track numbers, duration of pieces of musics [sic] is displayed on the display 15 or the like using the control data saved in the data saving memory 18." This does not describe what is written or stored, but rather what is displayed. Other portions of Nunokawa et al. that mention the "control data saved in the data saving memory" add little to describe what is saved as control data that could define a "display state." Instead, Nunokawa et al. discloses that "the recording position of each piece of musics (tracks) [is] determined from the control data" (column 8, lines 44-45) and

predetermined information in the above-described method of display may be control data for a predetermined recording medium and, when it is determined that the recording medium has not been replaced before the power supply is

turned on after once being turned off, a process is performed to display information recorded on the recording medium based on the control data read from a non-volatile storage

(column 9, line 65 to column 10, line 5). Statements similar to the preceding quotation appear at column 10, line 61 to column 11, line 3 and column 11, lines 39-48.

As discussed in the Appeal Brief, Nunokawa et al. provides a description of what is stored as "control information" which appears to be a term used interchangeably with "control data." A few lines prior to what was cited in Nunokawa et al. by the Examiner's Answer as allegedly disclosing "writing display information for indicating a display state," is the statement "control information ... [is] TOC, disk label, etc... of the disk" (column 8, lines 31-32). As discussed in the Appeal Brief, such data is not equivalent to and does not suggest storing "display information for indicating a display state" (claim 1, line 9), because the information that is stored or written according to the present invention changes in response to operations performed by the user, while Nunokawa et al. teaches storing data that never changes, so that "information including track numbers, duration of pieces of music ... [can be] displayed on the display" (column 8, lines 47-49).

It is submitted that what the Examiner's Answer cited in Nunokawa et al., as disclosing "writing display information for indicating a display state" does not support the rejection, particularly when this passage is read in context with the preceding paragraph in Nunokawa et al. It is submitted that one of ordinary skill in the art would not be taught by Nunokawa et al. to save a "display state," but rather to save control information or data about the disc that was in use prior to an automotive vehicle being turned off. While such information can be used to generate a display, it does not contain "display information for indicating a display state" as required by all of the independent claims.

The Court of Appeals for the Federal Circuit has stated that "factual inquiry whether to combine references must be thorough and searching ... [and] must be based on objective evidence of record,"¹ citing several prior decisions.² These decisions were not overruled by *KSR*

¹ *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

² *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczaik*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*,

*International Co. v. Teleflex Inc.*³ in 2007. Rather, as held by the Court of Appeals for the Federal Circuit in March 2008, the teaching, suggestion, or motivation (TSM) test for obviousness,

flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence –teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) – that arise before the time of invention as the statute requires. As *KSR* requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans⁴

However, the Examiner has not relied on "the knowledge and creativity of ordinarily skilled artisans," but rather has asserted that Nunokawa et al. teaches something (writing display information for indicating a display state) that, as shown above, a fair reading of Nunokawa et al. as whole shows that Nunokawa et al. does not teach. Since what was cited in Nunokawa et al. as allegedly disclosing "writing display information for indicating a display state," when read in context, does not disclose what the Examiner has asserted it teaches, the Examiner has failed to provide evidence for combining Nunokawa et al. and Ogawa et al., as discussed below in more detail.

The Examiner has provided no reason for a person of ordinary skill to modify the teaching in Nunokawa et al. regarding saving the table of contents (TOC) or label of an audio compact disc (CD) to save time in generating a display by also storing "positional coordinates of the menu information ... [and] maps of various scales and the positional coordinates of the maps when displayed on the screen" as taught by Ogawa et al. at column 4, lines 22-25. Although Nunokawa et al. discloses a system that saves "predetermined information" relating to a map as

160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

³ 127 SCt 1727, 167 LEd2d 705, 82 USPQ2d 1385 (U.S. 2007)

well control data (information) relating to an audio CD, the Examiner's Answer only cited what Nunokawa et al. teaches about saving "the control data" for "pieces of music..." not what "predetermined information" is saved when a map is displayed. As far as can be determined, the reason that column 8, lines 47-49 was cited, instead of some other portion of Nunokawa et al., is that apparently Nunokawa et al. does not describe what "predetermined information" is saved when a map is being displayed.

The rejection of the claims set forth on pages 3-5 of the Examiner's Answer asserted that it would have been obvious to one skilled in the art to combine the method as taught by Nunokawa in combination with the method as taught by Ogawa in order to easily retrieve the latest image just before the power being turned off, and thereby providing convenience to the user, and reducing power consumption (Examiner's Answer, page 4, lines 11-15). However, "retriev[ing] the latest image just before power ... [is] turned off" is not what is recited in the claims and the assertion of an obviousness combination ignores the differences between the specific teaching relied on in Nunokawa et al. (saving control data of an audio CD) and the specific teaching relied on in Ogawa et al. (saving maps and coordinates). As discussed above, the independent claims require "writing display information for indicating a display state, including a displayed position and magnification, of a currently displayed image" (e.g., claim 1, lines 9-10), not so that "the latest image" is "retrieve[d]" but so that when the image data that was used to generate the most recent display can be processed for display to obtain the same positioning and magnification of the image that occurred before the "main power supply is switched off" (e.g., claim 1, line 4).

For the above reasons, it is submitted that by asserting a person of ordinary skill would find it obvious to combine the teaching in Nunokawa et al. regarding saving control data for an audio CD with what Ogawa et al. discloses about saving "maps of various scales and the positional coordinates of the maps," the Examiner's Answer failed to make a *prima facie* case of obviousness, by failing to provide evidence supporting the obviousness of that combination.

Furthermore, it is submitted that even if it was obvious to combine relevant teachings of Nunokawa et al. and Ogawa et al., the resulting combination would not meet all of the limitations recited in the independent claims. Ogawa et al. only discloses saving "the positional coordinates of the image currently displayed as map information" (column 5, lines 30-31) before "the CPU 10 turns the power OFF" (column 5, line 35) and that "maps of various scales" (column 4, lines 23-24) are stored in an EEPROM. Nothing has been cited in Ogawa et al. (or Nunokawa et al., for

⁴ *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 86 USPQ2d 1196, 1202 (Fed. Cir. 2008)

that matter) that provides any suggestion of storing the "magnification ... of a currently displayed image in the non-volatile storage unit" (e.g., claim 1, lines 10-11).

The Examiner's Answer did not cite anything in Ogawa et al. other than "column 4, lines 17-25 and Figs. 1-5" (generally) in response to the argument in the Appeal Brief that the portions of Ogawa et al. cited at page 4, line 11 of the Examiner's Answer as allegedly disclosing "writing display information for indicating a display state" (claim 1, line 9) merely describe the display of a menu for an enlarging/reducing process and the performance of enlarging/reducing based on instructions from a user, not saving the "magnification ... of a currently displayed image" (e.g., claim 1, line 10). For the reasons set forth above, it is submitted that the arguments in the Appeal Brief have not been overcome.

Furthermore, the Examiner's Answer failed to deny that the claimed invention provides benefits that are not suggested by either Nunokawa et al. or Ogawa et al. Therefore, those arguments in the Appeal Brief rebutting the alleged obviousness of combining Nunokawa et al. and Ogawa et al. by pointing out the benefits of the invention over the (unobvious) combination of Nunokawa et al. and Ogawa et al., are still valid in accordance with *Graham v. John Deere Co. of Kansas City*⁵.

For the above reasons, it is submitted that claim 1, as well as claims 2-4 and 5-10 which depend therefrom and claims 11-15 which include the limitations discussed above with respect to claim 1, patentably distinguish over Nunokawa et al. in view of Ogawa et al.

The only response in the Examiner's Answer to the arguments regarding the additional distinctions recited in claims 2, 5, 7, 9 and 10 was to cite column 10, lines 17-22 and 52-60 of Nunokawa et al. and assert that "since the display information includes the positional coordinates, each map data corresponding to a position is thus stored and retrieved independently" (Examiner's Answer, page 6, lines 17-19) without explaining whether the claims or which one of the references was being discussed on lines 17-19. It is submitted that this is inadequate to rebut the arguments in the Appeal Brief regarding the additional distinctions recited in claims 2, 5, 7, 9 and 10, at least due to the lack of explanation regarding the relevance of the cited portions of Nunokawa et al. or the unsupported statement at page 6, lines 17-19. Therefore, it is submitted that claims 2, 5, 7, 9 and 10, as well as claims 3, 4 and 8 which depend therefrom, further patentably distinguish over any combination of Nunokawa et al. and Ogawa et al. due to the additional distinctions discussed in the Appeal Brief.

⁵ 383 U.S. 1, 148 USPQ 459 (U.S. 1966).

For the reasons set forth above and in the Appeal Brief and responses filed during examination of the application, it is submitted that claims 1-5 and 7-15 patentably distinguish over Nunokawa et al. and Ogawa et al. Thus, it is respectfully submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

If any fee is required with respect to this Reply Brief, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: /Richard A. Gollhofer/
Richard A. Gollhofer
Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501